

U.S. Application No. 09/608,184 Examiner Christopher J. Brown Art Unit 2134
Response to March 29, 2004 Office Action

RESPONSE

In response to the Office Action dated March 29, 2004, Assignee respectfully requests reconsideration based on the following remarks. Assignee respectfully submits that all pending claims (1-54) are in condition for allowance.

The United States Patent and Trademark Office (the "Office") objected to the specification, rejected claims 37 and 38 under 35 U.S.C. § 112 as being indefinite and failing to particularly point out and distinctly claim the invention, rejected claims 1-6, 10-27, 29-31, 33-35, 39, and 40 under 35 U.S.C. § 102(b) as being anticipated by Blonder (U.S. Patent No. 5,708,422), and rejected claims 7-9 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Blonder (U.S. Patent No. 5,708,422) in view of Goldsmith (U.S. Patent No. 6,064,990). The Assignee shows, however, that the pending claims point out and distinctly claim the invention and that the pending claims are not anticipated, nor obviated, by the cited art. Thus, the Assignee respectfully submits that the pending claims (claims 1-54) are ready for allowance.

August 4, 2004 Interview:

On August 4, 2004, an interview (hereinafter referred to as "the Interview") was held with Christopher Brown (Examiner), Gregory Morse (Examiner Brown's Supervisor), Samuel Zellner (Inventor), Jennifer Medlin (Attorney for Assignee), and Barnbi Walters (Attorney for Assignee). During the interview, the participants discussed the objection and rejections of the March 29, 2004 Office Action, the term "notification message" as described on page 11, lines 8-17 and on page 16, lines 1-11 of U.S. Patent Application No. 09/608,184, and that commercial transaction included any "unauthorized access" such as credit, debits, account activity, and access to the account as described on page 15, lines 21-22 and page 16, lines 1-11 of U.S. Patent Application no. 09/608,184.

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Specification:

In the reason for objecting to the specification, the Examiner finds that the specification states that "[o]n page 13, lines 1-2 the specification states that if no threshold amount is exceeded no notification message is sent. In an example of the invention on page 14 lines 10-12, the specification states that if the threshold is exceeded, no notification message will be created." March 29, 2004 Office Action (hereinafter referred to as "Office Action"), p. 2, paragraph 1. As discussed during the Interview, the invention provides systems and methods for communicating a notification message both when the threshold amount is exceeded (e.g., when the payer establishes a threshold amount for receiving the notification message and the amount of the commercial transaction exceeds that threshold amount, then the notification message is communicated to the payer) and when the threshold amount is not exceeded (e.g., the notification message is created and the processing center may have different criteria that initiates communication of the notification message to the payer).

§112 Rejection:

In the Office Action, the Examiner rejected claims 37 and 38 under 35 U.S.C. § 112 as being indefinite stating that claim 37 is "in exact opposition to claims 13, 19, 26, and 33" and that claim 38 is "in exact opposition to claims 14, 18, 27, and 34." Office Action, p. 3, paragraph 1. As discussed during the Interview, the invention provides systems and methods for communicating a notification message both when the threshold amount *is exceeded* (e.g., when the payer establishes a threshold amount for receiving the notification message and the amount of the commercial transaction exceeds that threshold amount, then the notification message is communicated to the payer) and when the threshold amount *is not exceeded* (e.g., the notification message is created and the processing center may have different criteria that initiates communication of the notification message to the payer). Similarly, the invention provides systems and methods for communicating a notification message both when the filter definition *is met* (e.g., when the payer establishes a filter definition for receiving the notification message and the filter definition is met for the commercial transaction, then the notification message is communicated to the payer) and when the filter definition *is not met* (e.g., the notification message is created and the processing center may have different criteria that initiates communication of the notification message to the payer).

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§102 Rejection:

The Office rejected claims 1-6, 10-27, 29-31, 33-35, 39, and 40 under 35 U.S.C. § 102(b) as being anticipated by *Blonder* (U.S. Patent No. 5,708,422). A claim is anticipated only if each and every element is found in a single prior art reference. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). See also DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter "M.P.E.P."). As the Assignee shows, however, the reference to *Blonder* fails to include every element of the pending claims. The reference to *Blonder*, then, does not anticipate this invention, and Assignee respectfully requests that Examiner Brown remove the 35 U.S.C. § 102 (b) rejection of claims 1-6, 10-27, 29-31, 33-35, 39, and 40.

Blonder does not anticipate the claimed subject matter. Independent claims 1 and 10 describe methods and systems for monitoring a commercial transaction. Currently amended claims 1 and 10 include a notification message that includes a help communications address for assistance with the commercial transaction. See amended claims 1 and 10. Further, as discussed in the Interview, the help communications address of the notification message provides the account holder with the means to notify an appropriate authority in the event of unauthorized access, at the time the account is accessed, close in time when the account is accessed, and/or later in time after the account is accessed. See U.S. Patent Application No. 09/608,184, page 16, lines 1-11. For example, the help communications address may assist in establishing a communications connection to report criminal activity to a law enforcement agency, a credit card company and/or processing center, and a credit reporting agency (e.g., Equifax). See U.S. Patent Application No. 09/608,184, page 11, lines 8-17.

Independent claims 17 and 22 describe methods and systems for reducing fraud in a commercial transaction. Similar to above, claims 17 and 22 include a notification message that includes a help communications address for assistance with the commercial transaction. See amended claims 17 and 22. The help communications address of the notification message provides the account holder with the means to notify an appropriate authority in the event of unauthorized access, at the time the account is accessed, close in time when the account is

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accessed, and/or later in time after the account is accessed, and, consequently helps to reduce fraud in the commercial transaction and/or in future commercial transactions. See U.S. Patent Application No. 09/608,184, page 16, lines 1-11. For example, the help communications address may assist in establishing a communications connection to report criminal activity to a law enforcement agency and/or a credit card company and/or processing center. See U.S. Patent Application No. 09/608,184, page 11, lines 8-17.

Blonder does not mention these claim elements. *Blonder* describes (1) an automated method for authorizing a transaction in which the customer is informed of a pending authorization and the transaction is then authorized in response to a customer confirmation and (2) a method and system allowing a principal to be automatically alerted to and/or to promptly authorize an agent-initiated transaction which may be deemed atypical based on a pre-stored profile. *Blonder*, U.S. Patent No. 5,708,422, col. 2, lines 53-60. *Blonder*, however, fails to even remotely describe or suggest communicating a notification message that includes a help communications address. Rather, *Blonder* discloses the alert of FIG. 4 comprising the card holder's name, a display field, and a field that is populated by an entry in the table of FIG. 5. See *Blonder*, col. 7, lines 32-65. Thus the alert of *Blonder* is not associated with a help communications address.

Further, *Blonder* does not describe or suggest communicating the notification message when the commercial transaction involves a *credit to* an account, *access of* the account, or *non-debit related activity*. Rather *Blonder* discloses receiving an alert of a request for a debit and/or requesting approval/disapproval from the customer as part of the card validation process requesting a debit to a credit card account. *Blonder*, col. 3, lines 21-31 and col. 4, lines 30-33. Consequently, the alert disclosed in *Blonder* does not present a notification to the customer when there is a credit (e.g., returned merchandise) to the credit card account nor does *Blonder* present a notification when there is an access of the account (e.g., request for an amount of a recent purchase from a merchant).

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Still further, *Blonder* does not describe or suggest a notification message that includes a response by a processing center that alerts the payer whether a request for authorization has been approved or denied by the credit card processing center. Rather, *Blonder* discloses that "... the card owner may elect to simply receive the alert message or to authorize/deny the charging of the expenses to the card number by transmitting an approval/disapproval message to the card issuer as part of the card validation process." *Blonder*, col. 3, lines 27-30.

For these reasons and others, *Blonder*, then, cannot anticipate claims 1, 10, 17, and 22. New independent claims 42 and 50 recite similar features as claims 1 and 10 and are also considered to be allowable over *Blonder*. Because claims 2-6, 11-16, 18-21, 23-27, 43-49, and 51-54 depend upon claims 1, 10, 17, 22, 42, and 50, respectively, *Blonder* cannot anticipate these claims. Accordingly, Assignee respectfully requests Examiner Foster to withdraw the §102 rejection and allow the pending claims.

Claims 29-31, 33-35, 39, and 40

Referring now to the rejection of dependent claims 29-31, 33-35, 39, and 40, the Examiner did *not* reject corresponding independent claims 28, 32, or 36 under §102(b), and consequently, the Assignee respectfully asserts that the Examiner has not met the burden of proving that each and every element is found in a single prior art reference. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). See also DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter "M.P.E.P."). Consequently, Assignee respectfully requests that Examiner Brown remove the 35 U.S.C. §102(b) rejection of these claims.

§103 Rejection:

The Office rejected claims 7-9 and 28 under 35 U.S.C. § 103(a) as being unpatentable over *Blonder* (U.S. Patent No. 5,708,422) in view of *Goldsmith* (U.S. Patent No. 6,064,990). If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2)

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there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P."). As the Assignee shows, however, the combination of *Blonder* and *Goldsmith* again wholly fails teach or suggest the claim limitations. The Assignee, then, respectfully requests allowance of claims 7-9 and 28.

The combination of *Blonder* and *Goldsmith* does not obviate the pending claims. *Blonder*, as mentioned above, describes (1) an automated method for authorizing a transaction in which the customer is informed of a pending authorization and the transaction is then authorized in response to a customer confirmation and (2) a method and system allowing a principal to be automatically alerted to and/or to promptly authorize an agent-initiated transaction which may be deemed atypical based on a pre-stored profile. *Blonder*, U.S. Patent No. 5,708,422, col. 2, lines 53-60. *Goldsmith* describes a system for electronically transmitting a message that includes account identification information and a description of the account activity to a user of account. *Goldsmith*, U.S. Patent 6,064,990, column 6, lines 47-53. The combination of *Blonder* and *Goldsmith* wholly fails to even remotely recite the limitations of currently amended claim 7-9 and 28. Neither *Blonder* nor *Goldsmith* teaches or suggests the limitation of the notification message including a help communications address for assisting with the financial transaction. Because the combination of *Blonder* and *Goldsmith* fails to teach or suggest this limitation, these claims would not have been obvious to one of ordinary skill in the art. The Assignee, then, respectfully asks Examiner Foster to remove the § 103 rejection and to allow the pending claim.

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CONCLUSION

All of the objections and rejections have been overcome. Further, none of the references cited by Examiner Brown, alone or in combination, disclose or suggest the claimed invention. Therefore, Assignee respectfully solicits a Notice of Allowance for all pending claims (claims 1-41).

AUTHORIZATION FOR PAYMENT OF FEES

If there are any other fees due in connection with the filing of this response, please charge the fees to the credit card on file. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to the credit card on file.

If the Office has any questions, the Office is invited to contact the undersigned at (757) 253-5729 or bambiwalters@cox.net.

Respectfully submitted,



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